



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

(H)

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/101,341	07/08/98	MALMGREN	K 000500-128 EXAMINER

HM12/0303

BURNS DOANE SWECKER & MATHIS
GEORGE MASON BUILDING
WASHINGTON & PRINCE STREETS
PO BOX 1404
ALEXANDRIA VA 22313-1404

ART UNIT	PAPER NUMBER
WHITE, E	4

DATE MAILED:

03/03/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 - 15 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

BEST AVAILABLE COPY

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 1 of claim 1, line 2 of claim 2, line 2 of claim 12, and line 1 of claim 13, the term "characterized by" should be changed to ---comprising--- in order to make the claims more definite.

Claim 2 sets forth improper Markush terminology which renders the claim indefinite.

In line 2 of claims 3-11, line 1 of claim 14, and line 2 of claim 15, the term "characterized in that" should be changed to ---wherein--- in order to make the claim more definite.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 15 recites the broad recitation "an absorbent article", and the claim also recites the group "diaper, an incontinence guard or a sanitary napkin" which is the narrower statement of the range/limitation.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrow (EP 232,121) in view of Holst et al (US Patent No. 4,197,371).

Applicants claim a method of producing polysaccharide fibres, characterized by dissolving a polysaccharide in a solvent, and spraying the solution into a bath which contains a water-miscible organic solvent and a cross-linker.

Burrow discloses a process for producing absorbent fibres by dissolving a carboxylate ester of the polysaccharide in an organic solvent, preferably with a latent cross-linking agent for the polysaccharide, extruding the solution through a jet into an aqueous medium to form fibres and subjecting the fibres to conditions which cause hydrolysis of the ester groups in the polysaccharide and cross-linking of the hydroxyl groups so formed by the latent cross-linking agent (see abstract). See column 3, line 46 wherein the organic solvent may be acetone which is disclosed in claim 4 of the instant application. Also see example 1, column 6, line 5 of the Burrow reference wherein the final process step involve drying the fibres. The Burrow reference differ from the instant claims by disclosing the cross-linker as being polyvinylamine or Polybrene. However, the attachment of such compounds to polysaccharides is well known in the art as

suggested in the Holst et al reference. See column 6, line 67 of the Holst et al patent wherein polyvinylamine can be grafted onto cellulose. One of ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product because the skill artisan would have expected the analogous starting materials to react similarly.

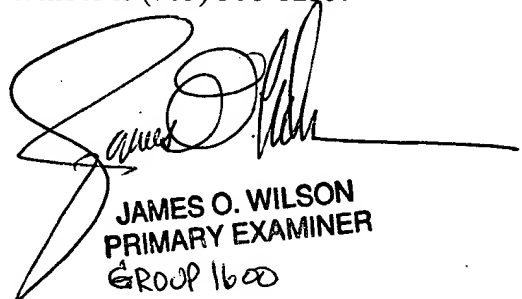
5. All the claims are rejected.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner signing this office action, James O. Wilson, can be reached on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E. White
White
February 26, 1999


JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600